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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/566,564 | 09/13/2006 | Jennefer Margaret Tobin | 23528 | 7358 |
| 535 | 7590 | 05/26/2009 | EXAMINER | |
| K.F. ROSS P.C. 5683 RIVERDALE AVENUE SUITE 203 BOX 900 BRONX, NY 10471-0900 | | | SHERMAN, STEPHEN G | |
| ART UNIT | PAPER NUMBER | 2629 | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|---------------------------------------|---|
| Office Action Summary | Application No. 10/566,564 | Applicant(s) TOBIN, JENNEFER MARGARET |
| | Examiner STEPHEN G. SHERMAN | Art Unit 2629 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 31 January 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-13 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-13 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 31 January 2006 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-166/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell et al. (US 6,703,570) in view of Lapstun (US 7,108,192).

Regarding claim 1, Russell et al. disclose a digital pen, comprising a writing instrument for use by a user to create penstrokes (Figure 1, 10) characterized in that the pen is used in association with a plurality of identity tags (Column 8, lines 42-47),

each tag being fixed at a location at which penstroke data are to be recorded, and the identity of each tag being stored in association with its location (Figure 9 and column 8, lines 42-55);

and in that there is provided identity tag reading means associated with the pen for reading the identity of each identity tag (Column 8, lines 33-35),

together with means for associating the identity read from each said identity tag with the penstroke data recorded at its associated location (Column 9, lines 44-54).

Russell et al. fails to explicitly teach wherein the digital pen includes means for recording the penstrokes as penstroke and means for uploading the penstroke data to a computer.

Lapstun discloses a digital pen including means for recording the penstrokes as penstroke and means for uploading the penstroke data to a computer (Column 22, lines 46-51 explain that the pen has an internal memory for storing the handwriting data and then the data is sent to a computer).

Therefore, since Russell et al. and Lapstun each disclose of a digital pen for creating penstrokes, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to substitute one digital pen with the other in order to achieve the predictable result of creating penstrokes.

Regarding claim 2, Russell et al. and Lapstun disclose a digital pen according to claim 1.

Russell et al. also disclose the digital pen characterized in that the identity tag reading means is integral with the pen (Column 8, lines 33-35).

Regarding claim 3, Russell et al. and Lapstun disclose a digital pen according to claim 1.

Russell et al. also disclose the digital pen characterized in that means are provided for associating at least a first tag identity with specified conditions, such that penstroke data are associated with the first tag identity only where the penstroke data are recorded and the first tag identity is read by the identity tag reading means in accordance with the specified conditions (Column 8, lines 32-60 and column 9, lines 44-67 explain that the handwriting is recorded and tag is read in accordance with a specified condition of the identity tag, i.e. as explained in the section, the action corresponds to the tag, i.e. New, Misc, etc.).

Regarding claim 4, Russell et al. and Lapstun disclose a digital pen according to claim 3.

Lapstun also discloses the digital pen characterized in that there is provided at least one personal identification tag, the identity of the personal identification tag being stored in association with the identity of the user (Column 25, lines 8-20 and column 26, lines 40-58, where the registration server stored the user signature, i.e. the personal identification tag.) ,

and the conditions specify that at least one personal identification tag must be read by the identity tag reading means in association with the recorded penstroke data (Column 25, lines 8-20 and column 26, lines 40-58 explain that the signature must be verified, i.e. the tag is read, before the handwriting data can be stored for the signature field.).

Regarding claim 5, Russell et al. and Lapstun disclose a digital pen according to claim 3.

Russell et al. also disclose the digital pen characterized in that indicating means are provided for indicating to the user whether or not the specified conditions have been satisfied (Column 8, lines 51-55 and column 9, lines 25-27 explain that an indicator light turns color dependent upon the category or action tag, i.e. the specified condition.).

Regarding claim 6, Russell et al. and Lapstun disclose a digital pen according to claim 3 or claim 4.

Lapstun also discloses the digital pen characterized in that the conditions specify a maximum time period which may elapse between reading the first tag and/or the personal identification tag and recording the associated penstroke data (Column 22, lines 4-19 explain that a selection is discarded after a defined time period between when the pen data is recorded and selected to when it is tagged to a hyperlink, and thus only penstroke data recorded with the time period will be tagged to the hyperlink, since it is discarded after the time period is over.).

Regarding claim 7, Russell et al. and Lapstun disclose a digital pen according to any of claims 1 – 5.

Russell et al. also disclose the digital pen characterized in that means are provided for recording in association with the penstroke data the time and date at which the data were recorded or uploaded (Column 9, lines 45-48).

Regarding claim 8, Russell et al. and Lapstun disclose a digital pen according to any of claims 1 – 5.

Russell et al. also disclose the digital pen characterized in that the identity tag reading means comprises contact identity tag reading means for reading the identity of an identity tag by physically contacting the tag (Column 5, lines 33-60 explains that the tip of the pen touches the surface while column 8, lines 33-35 explain that the tags are on the surface, thus the tag reader physically touches the tag on the surface.).

Regarding claim 9, Russell et al. and Lapstun disclose a digital pen according to any of claims 1 – 5.

Russell et al. also disclose the digital pen characterized in that the identity tag reading means comprises a barcode reader (Column 8, lines 33-35).

Regarding claim 10, this claim is rejected under the same rationale as claim 1, and furthermore Russell et al. defines that (a) the tag is read first (Column 8, lines 51-53

explain that the category tag is read first) then (b) penstroke data is recorded (Column 8, lines 53-55 explain that the writing will happen next) and then (c) the penstroke data is processed and stored in association with the tag (Column 8, lines 53-55 and column 9, lines 44-54).

Regarding claim 11, this claim is rejected under the same rationale as claim 6.

Regarding claim 12, this claim is rejected under the same rationale as claim 6.

Regarding claim 13, this claim is rejected under the same rationale as claim 4.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Obrea (US 2004/0230542) discloses of a digital pen used for recording information and reading tags.

Waddington et al. (US 2002/0010661) disclose of a PDA used for accepting signatures for packages in association with a tag being read.

Michael et al. (US 2003/0088442) disclose of a inventory management system involving obtaining verification signatures using a PDA and scanning barcodes to relate certain samples to the signature (handwritten information).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEPHEN G. SHERMAN whose telephone number is (571)272-2941. The examiner can normally be reached on M-F, 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on (571) 272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/566,564
Art Unit: 2629

Page 10

/Stephen G Sherman/
Examiner, Art Unit 2629

/Amr Awad/
Supervisory Patent Examiner, Art Unit 2629

21 May 2009